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| EXAMINER | |
|---|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2164 | |

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/748,050 | MORAIN ET AL. | |
| | Examiner | Art Unit | |
| | Sam Rimell | 2164 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23-28: The phrase "the usage results" lacks antecedent basis in each of these claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 and 23-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. (U.S. Patent 6,466,915).

Claim 1: FIG. 1 illustrates a first device in the form of a terminal (200).

The terminal is a computer terminal and thus inherently includes a digital content storage system in the form of an internal memory.

The graphical user interface of FIG. 25 is a monitoring system that appears on the terminal and monitors the selection of specific files, such as the selection of "flower pattern one-piece dress". Making the selection generates usage data, such as color, size, price and quantity purchased, which are subsequently sent to the central processing center (100) in Fig. 1.

The data fields, such as the data fields containing the named color "pink" and the price "6.800" are the usage data storage system since these fields store the usage data until it is sent to the central processing center (100) in Fig. 1.

FIG.11 illustrates a table which forms the usage metrics system. The table permits inferenced conclusions, such as the conclusion that a customer prefers a particular size, as illustrated at C in FIG. 7C and described at col. 18, lines 1-6. The table of FIG. 11 is located in the order reception file (3) (col. 13, lines 66-67) which is part of the central processing center (100) and forms a second device remote from the first device (terminal 200).

Claim 2: The data of FIG. 11 is organized into a plurality of categories, including genre type (goods information---102).

Claim 3: The first device (electronic terminal) obtains its digital content from the merchant providing the goods.

Claim 4: Col. 17, lines 40-53, and in particular, lines 40-44 outline digital content recommendation system based on the information in the usage metrics. The customer may be recommended specific merchandise via digital advertisement ("goods introduction") to the customer on the basis of past purchases.

Claim 5: The merchant uses the usage metrics system to select products to recommend to the customer via digital advertisement ("goods introduction").

Claim 6: The merchant providing the content is a marketing company.

Claim 7: The selections which are made available to the customer are presented as digital documents (FIGS. 21, 22A-22C and 23).

Claim 8: See remarks for claim 1.

Claim 9: See remarks for claim 2.

Claim 10: See remarks for claim 3.

Claim 11: See remarks for claim 4.

Claim 12: See remarks for claim 5.

Claim 13: See remarks for claim 6.

Claim 14: See remarks for claim 1.

Claim 15: See remarks for claim 2.

Claim 16: See remarks for claim 3.

Claim 17: See remarks for claim 4.

Claim 18: See remarks for claim 5.

Claim 19: See remarks for claim 6.

Claim 23: The "usage results" have no antecedent basis, but as seen in FIG. 25, the resulting input data can include a preference for a color of an article or a size of an article.

Claim 24: The "usage results" have no antecedent basis, but as seen in FIG. 25, the resulting input data can indicate the consuming habits of a consumer, such as purchasing dresses.

Claim 25: See remarks for claim 23.

Claim 26: See remarks for claim 24.

Claim 27: See remarks for claim 23.

Claim 28: See remarks for claim 24.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. Patent 6,466,915) in view of Henrick (U.S. Patent 6,507,727).

Claims 20-22: FIGS. 5A-5C illustrate a portable device which can download digital audio content, such as a song file ("download song"). The portable device is thus a digital audio player. The digital content can be purchased (abstract, line 1).

It would have been obvious to one of ordinary skill in the art to modify the terminal (200) of Suzuki et al. to be a portable cellular terminal configured to additionally download audio content as taught by Henrick so as to permit portability of the terminal and permit both physical items (clothing) and digital content (songs) to be purchased from the same system.

Remarks

Applicant's arguments are primarily addressed to the features of claim 1. Applicant argues that Suzuki et al. does not teach the first device as containing all three of the digital content storage, monitoring system and usage data storage, and a second remote device containing the usage metrics system. Examiner maintains that Suzuki et al. does in fact teach such an arrangement of features. This is further illustrated by the discussion of claim 1 contained in this action.

This office action follows the filing of an RCE request and is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

Sam Rimell
Primary Examiner
Art Unit 2164